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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/129,238 08/05/98 SARDOY

V 4101-0206-55

022850 IM22/0611
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EXAMINER

YEE, D

ART UNIT

PAPER NUMBER

1742

DATE MAILED:

06/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application N .

09/129,238

Applicant(s)

SARDOY ET AL.

Examiner

Deborah Yee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8 to 17, 19 to 21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8 to 17, 19 to 21 and 23 is/are rejected.
- 7) ☒ Claim(s) 20 and 23 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claim 23 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 23 recites a coiling temperature of 563 to 620C whereas its parent claim 20 recites a coiling temperature of greater than 530 to 570C.

Double Patenting

Claim 20 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 8. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 to 17, 19 to 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over European patent 556834

EP'834 discloses ultra-low carbon steel sheet alloy with constituents whose wt% ranges overlap those recited by the claims; such overlap renders applicant's composition prima facie obvious despite differences in non-overlapping areas, see *In re Malagari*, 182 USPQ549. Moreover, steel sheet is processed in substantially the same manner as claimed by applicant, wherein a steel slab is hot roll at Ar3 to 950C, coil at 400 to 600C, cold roll after pickling, and continuous anneal at a temperature above recrystallization temperature, and temper roll. Note that temperature ranges for rolling, coiling and annealing overlap those recited by the claims; hence a prima facie case of obviousness is established.

Response to Arguments

Applicant's arguments filed May 9, 2001 have been fully considered but they are not persuasive. It was submitted that the newly amended claims distinguish over EP'834 because of the Al range being not more than 0.01%, and the step of continuously annealing the intermediate cold-rolled sheet at a temperature of between 640 to 670C. The limitation on annealing temperature in conjunction with the coiling temperature range for the hot-rolled sheet of between greater than 530 to 570C distinguishes over the process of the European patent, because the combination of the annealing temperature range and the coiling temperature range is not shown in the EP'834. It is the examiner's position that EP'834 discloses an annealing temperature at above the recrystallization temperature which is within the teaching of the claimed present invention. See ~~page 11~~, lines 19 to 33 on page 11 in applicant's specification which discloses that "the continuous annealing is carried out at temperature which is

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generally 20 to 30C above the recrystallization temperature of the steel...the annealing temperature is at most equal to 700C." Even though EP'834 discloses specific examples subjected to annealing at temperatures at 700C or higher which is greater than the claimed annealing temperature range of 640 to 670C, such would not be a patentable distinction since applicant has not demonstrated (e.g. by comparative test data) that the more narrowly claimed annealing temperature of 650 to 670C is somehow critical and productive of new and unexpected results. Same argument would applied to applicant's more narrowly claimed coiling temperature range of greater than 530 to 570C.

It was argued that Al, Nb, and Ti distinguish claims over prior art. Note that EP'834 alloy contains 0.005% or less which is within applicant's claimed Al range of no more than 0.01%. Moreover, the Nb and Ti in EP'834 are taught as optional not mandatory elements. Therefore, Nb and Ti need not be present, and hence would meet applicant's Ti and Nb range of no more than 0.001%, respectively.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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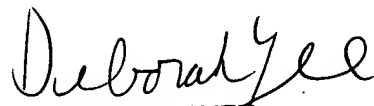
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 703-308-1102. The examiner can normally be reached on Monday-Friday from 6:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 703-308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-873-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

dy
June 7, 2001


DEBORAH YEE
PRIMARY EXAMINER